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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,926	08/21/2001	David Grawrock	SYMA-01045US0MCF/GGG	8871
23910	7590	02/23/2006	EXAMINER	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			CALLAHAN, PAUL E	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/934,926

Applicant(s)

GRAWROCK ET AL.

Examiner

Paul Callahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11-25-06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 33-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 48 is/are allowed.
- 6) ☒ Claim(s) 1-3, 33-47, 49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. Claims 1-3 and 33-49 are pending in this application and have been examined.

***Response to Arguments***

2. Applicant's arguments filed 11-25-05 have been fully considered but they are not persuasive.

The Applicant argues in traverse of the rejections of the claims under 35 USC 102(b) as clearly anticipated by Orita '147. The Applicant asserts that the instant claimed invention may be distinguished from the teaching of Orita based on the feature of the instant claimed invention of: storing and retrieving data files either locally or remotely. The Applicant asserts that the Orita reference only teaches local storage of such data files. The Applicant's argument is respectfully countered by noting that the recitation of storage of the data files locally or remotely is disjunctive, i.e., the retrieval is of data files stored locally or remotely, and therefore even assuming arguendo that Orita fails to teach remote storage, the local storage of Orita reads sufficiently on the claim limitation. In addition, files are retrievable (fig. 3 element 511, col. 2 lines 53-62) from a workstation (fig. 1 element 10) that is remote from the external hard-drive (fig. 1 element 11). Therefore Orita does teach all limitations of claims 1 and 2.

The Applicant argues in traverse of the rejection of claim 3 under 35 USC 103(a) by asserting that Rager '721 fails to teach remote retrieval of files and therefore cannot cure the asserted deficiency of Orita discussed supra. However, a review of Orita as discussed supra reveals that it does indeed teach this feature.

***Response to Amendment***

3. The amendment to the claims filed on 11-25-2005 does not comply with the requirements of 37 CFR 1.121(c) because the renumbering of the claims is improper, the claim listing is incomplete, and the claims do not have the proper status identifiers in all cases. Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(c) *Claims*. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing*. All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of “canceled” or “not entered” may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required*. All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of “currently amended,” and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of “currently amended,” or “withdrawn” if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.”

(3) *When claim text in clean version is required*. The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may

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have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a “new” claim with a new claim number.

4. Since the reply filed on 11-25-05 appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to submit an amendment in compliance with 37 CFR 1.121 in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 33-47 and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 33, 35, and 40 contain the phrases: “...files that primarily reside...”, “...files residing primarily...”, “...file primarily reside...”. From this claim language it is unclear at what

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location the file storage is found. Claims 34, 36-39, 41-47, and 49 are dependent on claims 33, 35, and 40 and are therefore rejected on the same basis.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Orita, 5163147.

As for claim 1, Orita teaches a machine system for protecting access constrained information from unauthorized access by way of unauthorized users or unauthorized programs, said machine system comprising (abstract, col. 1 lines 5-10):

(a) data-providing means for providing data of an identified one of two or more digital data files, where each of said files is identifiable by a file name and where each of said files is retrievable from either a local storage or from an external storage (fig. 1 item 14);

(b) an interceptable access mechanism through which data of an identified file of the data-providing means is accessed by identifiable, access-requesting programs and/or access-requesting users (abstract, col. 4 lines 46-68);

(c) access-control means coupled to intercept data access attempts made through said interceptable access mechanism, wherein the access-control means includes deny/approve means for testing the intercepted data access attempts and responsively denying or approving intelligible or other data access to the data of an identified subset of said files based on one or more of the identity of an access-attempting program, the time of the access attempt, the machine or location from which the access request originates and a user associated with the access request, and wherein the access-control means includes permissions control means for responding to permission rules associated with respective ones of identifiable subsets of said files (col. 4 lines 46-67, fig. 5); and

(d) localizing means for transparently and temporarily localizing external files and respective external permission rules of such external files for use by said access-control means (abstract, col. 1 lines 5-10).

As for claim 2, Orita teaches a machine-implemented method for protecting access constrained information from unauthorized access by way of unauthorized users or unauthorized programs, said machine-implemented method comprising (abstract, col. 1 lines 5-10):

(a) in response to a navigation-based request, providing data of an identified one of two or more digital data files, where each of said files is identified in the navigation-based request by a file name, file handle, or equivalent and where each of said files is retrievable from either a local storage or from an external storage (fig. 5, fig. 1 item 14, col. 4 lines 46-68);

(b) intercepting data access attempts made through an interceptable access mechanism, wherein (col. 4 lines 46-68):

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(b.1) the interceptable access mechanism is one through which data of an identified file of the data-providing means is accessed by identifiable, access-requesting programs and/or access requesting users (col. 4 lines 46-67, fig. 5); ;

(b.2) the interceptable access mechanism includes access control means includes deny/approve means for testing the intercepted data access attempts and responsively denying or approving intelligible or other data access to the data of an identified

subset of said files based on one or more of the identity of an access attempting program, the time of the access attempt, the machine or location from which the access request originates and a user associated with the access request (col. 4 lines 46-67, fig. 5); and

(b.3) the access-control means includes permissions control means for responding to permission rules associated with respective ones of identifiable subsets of said files; and said method further comprises (col. 4 lines 46-67, fig. 5); and

(c) in response to those of said navigation-based requests which request external files, transparently and temporarily localizing the external files and the respective external permission rules of such external files for use by said access-control means (abstract, col. 1 lines 5-10).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Orita as applied to claim 2 above, and Rager 5,412,721.

As for claim 3, Orita teaches the machine-implemented protecting method of Claim 2, but not wherein: confidential information is kept essentially and consistently in encrypted format when the confidential information either resides within a remote file server or within easily removable media or when such confidential information is in transit along an untrusted (not-secure) communications link; said confidential information is exposed in plaintext form on an as needed and as-authorized basis, essentially only when said confidential information resides within a local client that is conveniently viewable by one or more authorized users; said plaintext exposure is allowed to occur only after an authorized user validates his or her authorization to access the information at the local client. However Rager et al. does teach these features (abstract, Fig. 3B item 316) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into the system of Orita. It would have been desirable to do so as described in the abstract of Rager so as to prevent access to the data in the event of power to the memory device being shut off.

***Allowable Subject Matter***

11. The indicated allowability of claims 33-47 and 49 is withdrawn in view of the further consideration of the claim language and the new rejections of the claims under 35 USC 112 2<sup>nd</sup> Paragraph.

12. Claim 48 is allowed.

***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869.

The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

2-16-05

  
EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER